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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/638,457	08/14/2000	Eric Boyd	18567-0012	9536

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MORRISON & FOERSTER LLP  
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EXAMINER

ALVAREZ, RAQUEL

ART UNIT PAPER NUMBER

3622

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/638,457

Applicant(s)

BOYD ET AL.

Examiner

Raquel Alvarez

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8, 24, 25, 38, 40-42, 50-55, 58, 59 and 75-79 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 24, 25, 38, 40-42, 46, 50-55, 58, 59, 75 and 76 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 75 and 77-79 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This office action is in response to communication filed on 12/15/2005.
2. Claims 1-8, 24-25, 38, 40-42, 46, 50-55, 58-59, newly added 75-79 are presented for examination.

### ***Election/Restrictions***

3. Newly submitted claims 75, 77-78 and 79 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claim 75 is directed to determining when the auction should end; Claims 77-78 are directed to categorizing the points and rules for establishing the expiration of the points based on their category; claim 79 pertains to converting the points into cash and donating the cash value.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 75, 77-78 and 79 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### **Claim Rejections - 35 USC § 101**

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-8, 24-25, 38, 40-42, 46 are directed to non-statutory subject matter.

The claimed "logic" is directed to mere software per se. The claim is descriptive material per se and hence non-statutory. Computer software is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and therefore is not statutory.

**Claim Rejections - 35 USC § 103**

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-8, 24-25, 38, 40-42, 46, 50-55, 58-59 and 75, 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Copple et al. (6,178,408 hereinafter Copple) in view of Applicant's background of the invention.

With respect to claims 1, 38, 50, 40, 46, 76, Copple teaches an offline-Online points system operable to provide a user with an interface to submit a code obtainable from user from an item (col. 3, lines 64- to col. 4, lines 34); operable to maintain a set of valid codes and to determine whether the code submitted by the user is a valid code and if valid then to credit the user balance with other points credited for point actionable activities (col. 4, lines 5-26) redeemable for value including for an item which the user won in an auction (see Figure 4a); operable to track the point balance in an account with an account database having a plurality of accounts configurable for transferring

Art Unit: 3622

points therebetween (Figure 2a, 210); tracking a point balance of the user in an account of an account database having a plurality of accounts to transfer points among the plurality of accounts and to characterize each point of the point balance as one of purchase (col. 4, lines 8-26)

With respect to the actionable activities including an advertisement and registering with a website. Applicant admitted on page 2, lines 15-19 that it is old and well known for one of the activities for earning points is **clicking on advertisements, filling out registrations and surveys....**Users accumulate points into an account from which they can redeem their points for certain goods or services. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included for one of the actionable activities to include an advertisement and registering with a website because such a modification would allow customers to earn points for their time without having the need to make a purchase.

With respect to providing respective credit lines to users that are heavily active in order to supplement the point balance of their respective account with credit points. Official notice is taken that it is old and well known to provide credit lines to users that are heavily active in paying their debts on time because such users are low credit risk. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included providing respective credit lines to users that are heavily active in order to supplement the point balance of their respective account with credit points because such a modification would allow the system to advanced points to users that are likely to repay the borrow points.

With respect to claims 2-4, Copple further discloses maintaining a user account containing the points balance for the user and updates the user account after the user submits a valid code (col. 3, lines 64 to col. 4, lines 34).

With respect to claims 5-8, Copple discloses a system for an awards points account and therefore it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention was made to identify the coupon used in Copple using any numbers of letters, numbers and/or characters. One would have been motivated to allow the use of a variable length code on the coupon in order to increase the flexibility of the system to encompass both and large point systems, i.e. a large system with millions of users submitted multiple codes (e.g. 100) each would require identification codes much larger than a system with only 100 users who submit only 5 codes each.

With respect to claim 58, Copple discloses a system for an awards point and further discloses means for generating the code and fixing the code onto an offline medium (such as a product or product packaging)(col. 3, line 64 – col. 4, line 34).

With respect to claims 25, 59, Copple further discloses that the code (coupon) is affixed to the product or product packaging, it is not explicitly disclosed that the product packaging is a bottle cap. However, the inside surface of a bottle cap, the sides of plastic or paper food and beverage containers, the inside surface of candy

Art Unit: 3622

wrappers, etc. are all well known pads of product packaging used to carry and/or conceal game pieces and codes. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to print the code on the inside of a bottle cap of Copple's product. One would have been motivated to print the code on the bottle cap in order to prevent an unauthorized person from removing the code without purchasing the product.

With respect to claim 52, Copple explicitly discloses that point systems are known in which the points can be redeemed for a gift or discount (col. 1, lines 23-27).

With claims 53 and 54, Copple do not explicitly disclose the type of auction. The Examiner notes that the claimed auction types are all well known types of auctions. Furthermore, the type of auction being conducted has no effect whatsoever on the claimed system of accumulating and redeeming incentive points. Thus, little patentable weight is given to the type of auction or how the auction is run. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to know that any method of determining an item to purchase for which the award points would be redeemed could be used, to include any type of auction, since the procedure has no connection to the incentive awards method.

With respect to claims 41, 55, Copple further discloses adding or subtracting points from the account based on the users interaction (point-actionable event) with the

Art Unit: 3622

system; thus, maintaining a user account containing the points balance for the user and updates the user account after the user submits a valid code or a winning bid (col. 3, line 64 – col. 4, line 34).

With respect to claims 24, 42 and 51, Copple does not explicitly disclose that the user account would be placed behind a firewall and further protected using encryption. Copple discloses that a user's registration information also includes a "personalized log on password" (col. 5, lines 4-6). While it is not explicitly disclosed that the account data will also be encrypted, encryption is a well known security measure used to protect data especially when it is being transmitted over an unsecured network such as the Internet and, thus, would have been an obvious addition to the security measures disclosed by Copple.

### **Response to Arguments**

7. Applicant argues that Copple does not teach that the point actionable activities includes one or more viewing an advertisement and registering with a website. The Examiner agrees with Applicant but nevertheless Applicant admitted on page 2, lines 15-19 that it is old and well known for one of the activities for earning points is **clicking on advertisements, filling out registrations and surveys....**Users accumulate points into an account from which they can redeem their points for certain goods or services. The Examiner asserts that the combination of Copple combined with Applicant's admission teaches the claimed language.



Art Unit: 3622

8. Applicant argues that the Examiner has not demonstrated in the Official notice taken that heavily active users is congruent with determination of general credit worthiness. The Examiner has rewritten the Official notice to show that this feature is well known, in addition the Examiner is providing the Cunningham (6,014,645) reference to support the Official Notice taken. Cunningham teaches on col. 4, lines 16-64 that a person with a score of 700 and above will be considered credit worthiness and will be offered credit, a person with a credit score of 699 or below will not be offered any credit. The score is calculated based on customer's prior credit history such as being heavily active in paying their bills on time.

9. Applicant argues that Copple does not teach tracking a point balance of the user in an account database having a plurality of accounts to transfer points among the plurality of accounts and to characterize each point of the point balance as one of purchase and attention incentive points. The Examiner wants to point out that Copple teaches the system keeps track of the different points in a database, certain points are for points earned by making purchases and the like and some other points are points that are redeemed and are deducted from the user's account. All the points collected or redeemed are transferred to database 410.

10. Claims 75, 77-78 and 79 are restricted by original presentation and therefore the arguments with respect to this claims are moot.

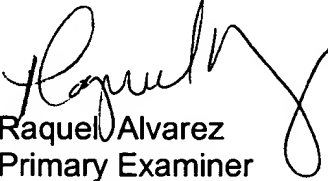
**Point of contact**

Art Unit: 3622

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w. Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Raquel Alvarez  
Primary Examiner  
Art Unit 3622

R.A.  
3/16/2006